

REMARKS

This application has been carefully reviewed in light of the Office Action dated March 18, 2005. Claims 1 to 9, 43 to 51, 67 and 68 are pending in the application, of which Claims 1, 4, 7, 43, 45, 47, 49 and 67 are independent. Reconsideration and further examination are respectfully requested.

The current Office Action repeated objections to the specification from the previous Office Action dated September 9, 2004. Specifically, the Office Action merely copied language from the prior Office Action, which objected to various language allegedly contained in Claims 4 and 42. Inasmuch as neither Claim 4 or Claim 43, as last amended in the December 8, 2004 Amendment, include the language on which the objections are based, the Office Action's position is wholly misplaced. Accordingly, the objections are traversed and the Examiner is requested to review the claims as last presented to confirm the cancellation of the language in question.

Claims 7 to 9, 47 and 48 were again been rejected under 35 U.S.C. § 101. Specifically, the Office Action took the position that a positive recitation of a computer within the body of the claim is required in order for a claim directed to a computer-readable memory medium to be statutory under § 101. However, U.S. patent law does not impose any such a requirement for compliance with § 101. Accordingly, the rejections are traversed.

The Office Action also indicates that the claims fail to produce a useful, concrete, tangible result. However, Applicant wishes to point out that, as clearly claimed in each of Claims 7 and 47, after detecting print settings and an upper limit of an amount to be paid for a print service, the claimed program selects a server and outputs information to

the server. Thus, the claims are believed to fully comply with § 101 and withdrawal of the rejections is respectfully requested.

Claims 4 to 6, 43 and 44 were rejected under 35 U.S.C. § 112, second paragraph. Specifically, the Office Action rejects the claims on the basis that the claimed "means for" is not linked or associated with any structure. In this contention, the Office Action is correct; but since the claims are written in means-plus-function terminology under 35 U.S.C. § 112, 6th paragraph, no corresponding structure is required to be cited in the claims. In this regard, § 112, 6th paragraph is unambiguous in that "[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function *without the recital of structure, material, or acts in support thereof*" (emphasis added) Thus, Applicant fails to understand the Examiner's position and believe it to be wholly misplaced. Accordingly, withdrawal of the § 112 rejections is respectfully requested.

Claims 1 to 9, 43 to 51, 67 and 68 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,615,234 (Adamske), Claims 1 to 9, 43 to 51, 67 and 68 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,826,244 (Huberman), Claims 1, 2, 4, 5, 7, 8, 49 and 50 were rejected under 35 U.S.C. § 103(a) over Adamske, and Claims 1 to 9, 43 to 51, 67 and 68 have been rejected under 35 U.S.C. § 103(a) over Huberman. The rejections are respectfully traversed and the Examiner is requested to reconsider and withdraw the rejections in light of the following comments.

With regard to the rejections over Adamske, looking to the detailed rejection in the Office Action, it merely alleges that Adamske teaches detecting various

types of print settings, and selecting a server. However, the Office Action fails to address the feature of detecting an upper limit of amount designated by a user to be paid for a print service. That is, one feature of the present invention is that, besides merely detecting print settings and selecting a server, a user inputs an upper limit of an amount to be paid for a print service, and based in the upper limit, second print settings are determined, and then a server is selected based on the print settings and the upper limit. The Office Action fails to even allege that Adamske teaches such a feature as detecting the upper limit. Thus, the Office Action has failed to establish that Adamske teaches all of the claimed features of the present invention so as to support an anticipation rejection.

Moreover, as Applicant understands Adamske, once a user has selected various print settings and delivery options, the user can input billing information (e.g., credit card number) to pay for the printing service. While not explicitly disclosed in Adamske, it can best be assumed that the amount the user is billed is based on the selected print settings and delivery options. However, Applicant fails to see anything in Adamske in which a user inputs an upper limit of an amount to be paid for the service, whereby second print settings are determined based on the upper limit, and a server is selected based on the first and second print settings and the upper limit. Accordingly, Applicant believes that the present invention also non-obviously different from Adamske.

Regarding the rejections over Huberman, the Office Action states that the Examiner cannot locate the feature of "second print setting information is determined for a second print service in accordance with detected first print setting information for a first print service and a detected upper limit of a charge designated by a user to be paid for the first print service" in the claims. However, Applicant fails to understand the Examiner's

reasoning since such a feature is clearly included in the amended claims. Again, the Examiner is referred to the December 8, 2004 Amendment for the latest version of the claims presented for examination.

Nonetheless, Huberman is not seen to disclose or to suggest the features of the present invention, and in particular, is not seen to disclose or to suggest at least the feature of determining second print setting information for a second print service in accordance with detected first print setting information for a first print service and a detected upper limit of a charge designated by a user to be paid for the first print service.

Huberman is merely seen to disclose a brokered auction service for document services. According to the patent, the system includes a customer process, a supplier process and a broker process. A customer submits a document service request (e.g., bid) and the broker process acts as an intermediary to auction the services between various suppliers. Once a price has been established, the document request can be performed by the winning bidder. Thus, while Huberman may involve print for pay services, Applicant fails to see anything in Huberman in which second print setting information is determined for a second print service in accordance with detected first print setting information for a first print service and a detected upper limit of a charge designated by a user to be paid for the first print service. Accordingly, Claims 1, 4, 7, 43, 45, 47, 49 and 67, as well as the claims dependent therefrom, are believed to be allowable over Huberman.

In view of the foregoing amendments and remarks, the entire application is believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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